



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/534,916	03/23/2000	David J. Marsh	MS1-525US	9507

22801 7590 11/21/2001

LEE & HAYES PLLC
421 W RIVERSIDE AVENUE SUITE 500
SPOKANE, WA 99201

EXAMINER

LEE, SEUNG H

ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 11/21/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Offic Action Summary	Application N .	Applicant(s)
	09/534,916	MARSH, DAVID J.
	Examiner	Art Unit
	Seung H Lee	2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 September 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 23, 47-49, and 51 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-22, 24-46, 50, 52-54 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) Interview Summary (PTO-413) Paper No(s). _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____

DETAILED ACTION

Receipt is acknowledged of the response filed on 5 September 2001, which has been entered in the file. Claims 1 - 22, 24-46, 50, and 52-54 are pending.

Specification

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 16, 19, 21, 24, 29, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Thompson et al. (US 5,805,204).

Re claims 16, 19, 21, and 24: a method of encrypts and decrypts the media content comprising:

Checking whether a smart card (11) is authorized to encrypt and decrypt the media content and encrypt and decrypt the media content only if the smart card is authorized to encrypt and decrypt the media content only if data (i.e., valid imbedded

key within smart card) other than electronic money is stored on the smart card (see col. 7, line 7 - 51),

Re claim 29: a method of allowing parental control over media content comprising

receiving media content (satellite receiver) (see Fig. 1);

encrypting the received media content based on a household identifier corresponding to a smart card (see Fig. 6; col., 6, line 60 – col. 7, line 2);

requiring the smart card (11) to be presented to decrypt and render the media content (see Fig. 7; col. 7, line 17 – 36),

Re claim 30: requiring the smart card to be inserted into a smart card reader coupled to a computing device (50) that is decrypting the media content (see Fig. 7).

4. Claims 34 - 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Handelman et al. (5,666,412).

Re claim 34: a method of allowing parental control over media content comprising:

comparing a rating corresponding to the media content (parental control) to a rating associated with a smart card and allowing access to the media content if the rating corresponding to the media content does not exceed the rating associated with the smart card (see col. 7, line 24 - 43),

Re claim 35: the rating associated with the smart card is stored on the smart card (see col. 3, line 18 - 23),

Re claim 36: the allowing access comprising allowing the media content to be decrypted (Descramble Program Channel) for rendering (see Fig. 2)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 5 - 8, 12 - 14, 28, 31- 32, 37 - 40, 42, 43 - 45, 50, and 52 - 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Handelman et al. (US 5,666,412) in view of Thompson et al. (US 5,805,204).

Handelman teaches the smart card with memory unit to store a user-specific information (i.e., parental control, access seeds) and to store a data that is value to the user (billing information) (see col. 3, line 12 - 35),

memory unit comprises a nonvolatile memory or Read Only Memory (ROM) (see col. 12, line 22 - 31),

the smart card corresponds to a particular category of media content that comprise a family oriented media which program does not require the parental control and adult oriented media which program requires the parental control (see col. 3, line 13 - 18),

the smart card is used to limit where rendering of the media content can occur (12, 112, and 212) (see col. 7, line 14 - 23),

the smart card having a processor to execute instruction to encrypt/decrypt the media content and to manage the user-specific information storage section (see col. 8, line 9 - 38),

maintaining user information on the smart card (28 and 30), the user preference information being available only when the smart card is coupled to the computing device (10) (see Fig. 1),

the network devices include to receive media content (10) and device to render media content (12) (see Fig. 1),

one of plurality of smart card is coupled to a device (10) when the smart card is inserted into a smart card reader coupled to the device (10) (see Fig. 1),

the network of devices is maintained within a single house (10) (see Fig. 1).

However, Handelman fails to teach or fairly suggest that the smart card comprise an associated household key to encrypt and decrypt the media content.

Thompson teaches the smart card (11) having the key to encrypt and decrypt the media content (see col. 7, line 7 - 17).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the smart card having a notoriously old and well known key to encrypt/decrypt the media content as taught by Thompson to teachings of Handelman in order to provide an improved parental control by encrypting the media content based on the key value of the smart card (i.e., adult and/or family oriented media content). Moreover, such modification would provide a control of the decrypting of the media content means wherein the smart card can be programmed to properly

decrypt the media content for specified time period (i.e., from 4:00 PM to 8:00 PM for children). Furthermore, such modification (i.e., encrypting of the media content from the CATV company or Satellite company) is unnecessary since the media content is already encrypted at the CATV company or Satellite company, and therefore an obvious expedient.

7. Claims 9 - 11, 20, 25 - 27, 33, 41, 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson et al. in view of Handelman et al.

The teachings of Thompson have been discussed above.

In addition to the teachings of Thompson, he also teaches the communication module to communicate to a computing device module that decrypt the media content based on the key value of the smart card (see col. 7, line 8 - 17), and one or more computer-readable memories (69 and 73) containing a computer program that is executable by a processor (71) to encrypt/decrypt the media content (see col. 6, line 21 - col. 7, line 7).

The teachings of Handelman have been discussed above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the notoriously old and well known smart card as taught by Handelman to the teachings of Thompson in order to provide an improved parental control by decrypting the media content based on the key value of the smart card (i.e., adult and/or family oriented media content). Moreover, such modification (i.e., the well known processor to execute the computer readable program in the memories)

would provide the means for encrypting/decrypting the media content based on the key value of the smart card, and wherein the smart card can be programmed to properly decrypt the media content for the specified time period (i.e., from 4:00 PM to 8:00 PM for children), whereas the media content would not decrypt properly for a viewing purpose, and therefore an obvious expedient.

8. Claims 3 - 4, 15,17 -18, 22, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Handelman et al. as modified by Thompson et al. in view of Teicher (US 5,744,787).

The teachings of Handelman have been discussed above.

Although, Handelman teaches the smart card to encrypt and decrypt the media content, he fails to teach or fairly suggest the smart card include electronic money.

Teicher teaches the smart card includes the electronic wallet (310) to make transaction only if the electronic wallet has enough money in the smart card (455) (see Fig. 3 and Fig. 5)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the electronic wallet as taught by Teicher to the teachings of Handelman/Thompson due to the fact that the processing time for one to order programs from the remote pay-per-view provider by the subscriber would be substantially reduced by eliminating the process/step of authorization/verification and debiting the value on the smart card at the moment the subscriber initiates the transaction/order. Moreover, such modification (i.e., the electronic wallet within the smart card) would provide a universal smart card to use at the multiple location/terminal

(i.e., Point Of Sales Terminal (POS), ATM, gas station) to purchase the products or services, and therefore an obvious expedient.

Response to Amendment

9. Applicant's arguments filed 5 September 2001 have been fully considered but they are not persuasive.

In response to the applicant's argument that the "*Thompson is directed to encrypting content not encrypting content after it is received at the user's home*" (page 5, line 6+), the Examiner respectfully disagrees with the applicants wherein Thompson teaches that the decoder unit (50) of the smart card (11) encrypts and decrypts the media content that which has been received from the remote media source, that is, at user's home or the premises (see Fig. 5 and 6; col. 6, line 21- col. 7, line 51).

In response to the applicant's argument that the "*Thompson does not disclose or suggestthat a smart card is authorized to encrypt and decrypt media content only if data other than electronic money is stored on the smart card*" (see page 5, line 20+), the Examiner respectfully disagrees with the applicants wherein Thompson teaches that the smart card including the embedded key to encrypt and decrypt the media content which is not electronic money and is expected to be value to a user in order to encrypt and decrypt the media content (see col. 7, lines 7 - 51) meets the claimed invention.

In response to the applicant's argument that the "*Handelman does not disclosea smart card is authorized to decrypt media contentin amended claim 21*" (page 6, lines 13+), the Examiner respectfully disagrees with the applicants wherein the claim 21 is rejected based on the prior art of Thompson as discussed above in paragraph 3.

In response to the applicant's argument that the "*Thompson does not disclose encrypting the received media content base on a household identifier corresponding to a smart card*" (see page 7 of the response filed on 9/05/2001), Thompson simply provides evidence of the household identifier or embedded key corresponding to a smart card to encrypt in order to encrypt media content, that is, personnel who posses the smart card with invalid identifier or key will not be allow to have the system encrypt the media content.

In response to the applicant's argument that "*Handelman does not disclose or suggest allowing multiple levels of control*" (page 8, lines 21+), the Examiner disagrees with the applicants wherein the Handelman clearly teaches the multiple levels of control, that is, restricted program and non-restricted program, as discussed in paragraph 4 above.

In response to the applicant's argument that the "*Handelman does not disclose or suggest the rating associated with a smart card being stored on the smart card*" (page 9, lines 9+), the Examiner respectfully disagrees with the applicants wherein the Handelman clearly teaches the parental control is stored in the smart card as described in paragraph 4 above. Apparently, applicant is distinguishing the rating system from the

parental control, whereby the Examiner believes that the two terminologies can be used interchangeably.

In response to applicant's argument that "*procedure and billing data are not user preferences and storage section to store user preferences*" (page 10, lines 22+), the Examiner respectfully disagrees with the applicants wherein the billing data could contain the user preferences (i.e., adult channels, premium channels such as HBO, Showtime, etc.) as described in the paragraph 6 above, and Handelman simply provides evidence of the storage section to store the user preferences. Therefore, when interpreting the claimed invention as broadly as is possible, the combination of the teachings of Handelman and the teachings of Thompson meets the claimed limitations.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure;

Handelman [US 5,592,212], Wasilewski et al. [US 6,157,719], Lee et al. [US 6,104,860] disclose a conditional access to pay television,

Stiefel et al.[US 6,126,069] discloses a fee-based system ,

Herrmann et al. [US 5,426,701] discloses a cable television converts box having a smart card,

Monnin [US 5,509,073] discloses a communication network between a central station and local receiver,

Benton [US 4,341,951] discloses a electronic funds transfer,

Mages et a. [US 6,035,329] discloses a method and system for implementing the pay-per-view DVD-ROM system.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Seung H. Lee whose telephone number is (703) 308-5894. The examiner can normally be reached on Monday to Friday from 7:30 AM to 4:00 PM.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax-phone number for this group is (703) 308-5841 or (703) 308-7722.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [michael.lee@uspto.gov].

Art Unit: 2876

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

shl
Seung H. Lee
Art Unit 2876
November 06, 2001



MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800